

**REMARKS**

Applicant requests the Examiner to reconsider and withdraw the rejection of claims 1-7 under 35 U.S.C. § 112, second paragraph, in view of the above corrective amendments. In particular, claim 1 (and its dependent claims) has been amended substantially to conform to the amended claim 1 **proposed by the Examiner** in the paragraph bridging pages 2 and 3 of the Office Action.

With specific regard to the Examiner's assertion that claim 4 is "indefinite because...", Applicant advises the Examiner that **claim 4** refers to a first "heating" step, as described in Applicant's specification at page 6, lines 5-8, after which the wheel is tempered so as to reduce the temperature by about 700°C as described at specification page 6, lines 9-16.

This tempering step is followed by an "annealing step" which heats the tempered braking portion to a temperature of between 400°C and 500°C as described at specification page 6, lines 22-24. This "annealing" step corresponds to the subject matter of **claim 5** (and to new claims 8 and 9).

Applicant respectfully **traverses** the rejection of claims 1-7 under 35 U.S.C. § 103(a) as being unpatentable (obvious) over Davis '445.

In this regard, Applicant respectfully submits that the subject matter of each of these claims would not have been obvious to a person of ordinary skill in the art of producing safety wheels, because such persons would not have been motivated to use the teaching of Davis for producing a **safety** wheel by the method defined in Applicant's claims 1-10.

More specifically, a safety wheel for a subway coach bogie running on pneumatic tires does not undergo the same stresses as the wheel of Davis, which is intended to roll on a railway.

The wheel produced by the invention including a braking portion (16) as well as a guiding portion (18) as explained in particular in lines 11-19 on page 1 of Applicant's specification. On the **contrary**, the railway wheel of Davis has a tread surface 22 that permanently rolls on the railway, as well as a heel portion 21 and a flange 23. Moreover, in Davis, the wheel is manufactured, in order not to "lose its circular character" (see lines 51-55 of page 1), which is **not necessary** in Applicant's invention.

Therefore, even though the hardness of portion 22 is greater than that of portions 21 and 23 in Davis, this feature is due to a technical problem that is completely different from that solved by the present invention.

Moreover, the railway wheel of Davis is not adapted to be used as a **safety** wheel. Thus, the flange portion 23 of Davis' wheel is **not** adapted for the **guiding** function of a **safety** wheel, since its radial dimensions are not sufficient. In other words, the radial dimensions of a "safety" wheel produced by the claimed invention must be far greater than that of Davis, since the braking portion 16 of the wheel of the invention is removed from the rail, in normal use (see specification page 1, lines 11-19).

Thus, for the above reasons, Applicant again respectfully submits that a person of ordinary skill in the art of making "safety wheels" would not have been motivated to use the teaching of Davis to produce a "safety" wheel according to Applicant's claimed method as defined in claims 1-10, whereby Applicant respectfully requests the Examiner to reconsider and

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. APPLN. NO. 10/724,695

withdraw the rejection under 35 U.S.C. § 103(a), and to find the application to be in condition for allowance with all claims 1-10; however, if for any reason the Examiner feels that the application is not now in condition for allowance, the Examiner is respectfully requested to **call the undersigned attorney** to discuss any unresolved issues and to expedite the disposition of the application. (New claim 10 is supported in Applicant's specification at least at page 7, lines 2-11; compare claim 1 in the issued parent patent No. 6,679,535.)

Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this application, and any required fee for such extension is to be charged to Deposit Account No. 19-4880. The Commissioner is also authorized to charge any additional fees under 37 C.F.R. § 1.16 and/or § 1.17 necessary to keep this application pending in the Patent and Trademark Office or credit any overpayment to said Deposit Account No. 19-4880.

Respectfully submitted,

/John H. Mion/  
John H. Mion  
Registration No. 18,879

SUGHRUE MION, PLLC  
2100 Pennsylvania Avenue, N.W.  
Washington, D.C. 20037-3213  
(202) 663-7901

WASHINGTON OFFICE  
**23373**  
CUSTOMER NUMBER

Date: January 23, 2006